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DEC 13 2006

OFFICE OF PETITIONS

In re Application of	:	
JAMES	:	
Application No. 09/674,996	:	ON PETITION
Filed: November 2, 2000	:	
Attorney Docket No. (None)	:	

This is a decision on the petitions under 37 CFR 1.137(a) and 1.102(c)(1), filed August 3, 2006, to revive the above-identified application and to make the above-identified application special based on applicant's health and age as set forth in M.P.E.P. § 708.02, Section III and IV respectively.

The petition under 1.137(a) is **DISMISSED**.

The petitions under 1.102(c)(1) are **DISMISSED**.

Any further petition to revive the application under 37 CFR 1.137(a) must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

PETITION UNDER 37 CFR 1.137(a)

The application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed December 1, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were properly obtained.¹ Accordingly, the application became abandoned on March 2, 2004.

To elaborate on the prosecutorial history, Petitioner (James) filed two amendments after final on March 2, 2004 and April 20, 2004 to point out the purported errors in the final action. An Advisory Action was mailed on April 20, 2004, indicating that the March 2, 2004 amendment

¹ A two-month extension of time fee was improperly charged to Deposit Account 08-0719 on June 2, 2004, belonging to a practitioner revoked on November 26, 2003.

did not comply with the requirements of 37 CFR 1.121, and on October 4, 2004, indicating that the April 20, 2004 amendment did not place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Petitioner untimely filed a Notice of Appeal on December 10, 2004.² A Notice of Abandonment was mailed December 13, 2004. Petitioner then filed a petition to withdraw the holding of abandonment under 37 CFR 1.181 on January 18, 2005. The petition was dismissed on June 21, 2006

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks item (3).

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute “unavoidable” delay. See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex

² 37 CFR 1.136(a) allows Applicants to buy an extension of time up to the maximum extendable period set by statute. 35 U.S.C. 133 gives applicants six-months to respond to a final action. The six-month period for response was June 1, 2004.

parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). For example, 37 CFR 1.135 states, in pertinent part:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

As 37 CFR 1.135(b) is a manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper reply, a delay is not “unavoidable” when the applicant permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. In the present situation, the record reflects that Petitioner made a two attempts to file an amendment after final action with the Office in response to the December 1, 2003 final action. These amendments were not complete and proper replies required to save the application from abandonment. The first submission on February 26, 2004 did not comply with the requirements for amendments as set forth in 37 CFR 1.121, and an Advisory Action was mailed April 20, 2006, detailing the relevant requirements. A second amendment was filed on April 30, 2004 pursuant to 37 CFR 1.121, but outside of the shortened three-month period for response set forth in the final action of December 1, 2003. A two-month extension of time was required. As stated previously, a two-month extension of time fee was improperly charged to the deposit account of a practitioner revoked on November 26, 2003. As such, the filing of the amendment of April 20, 2004 was untimely and should not have been considered.

Nonetheless while the examiner had no procedural authority to act on the application on or after March 2, 2004 since it was abandoned, the Advisory Action mailed October 4, 2004 also indicated that the amendment of April 30, 2004 did not place the application in condition for allowance or that the amendment did not place the application in better form for appeal by materially reducing or simplifying the issues for appeal. A proper reply under 37 CFR 1.113 to the final action of December 1, 2003 must have included one of the following: (a) a Notice of Appeal and appeal fee; (B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance; (C) the filing of an RCE (Request for Continued Examination) under 37 CFR 1.114 accompanied by a submission that meets the reply requirements of 37 CFR 1.111 and the requisite fee³; or (D) the filing of a continuing application under 37 CFR 1.53(b). Thus, James had several options available within the proscribed period for response to avoid abandonment. Failure to submit in

³ The amendment submitted April 30, 2004 is entitled, “Amendment with Request for Continued Examination[.]” As required by 37 CFR 1.114, the RCE was not accompanied by the requisite fee of \$770 (\$385 for small entity) and was filed without the extension of time fee.

the above-identified application one of the above options within the proscribed time period for response does not demonstrate that James acted with care or diligence that is generally used and observed by prudent and careful men in relation to their most important business.

Also, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

Further, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action.

See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994)(while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction). Therefore, the Office's failure to advise James that the amendment filed April 30, 2004 did not prima facie place the application in condition for allowance or of the failure to pay the extension of time within the allotted period for response does not render the delay in submitting the required reply to the final action of December 1, 2003 unavoidable.

Finally, it is axiomatic that the filing of this, or any other, petition, will not serve as a stay of the appeal proceedings in this, or any other, case. See 37 CFR 1.181(f). 37 CFR 1.181(f) states:

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

As such, in order to forestall any abandonment of this application, it was incumbent on applicant to file one of the above replies within the three-month period set for response or the Notice of Appeal was due on or before March 1, 2004, unless an additional extension(s) was requested and timely paid for, under 37 CFR 1.136(a). Thus regardless of the fact that the application was abandoned on March 2, 2004, the filing of a petition to the Technology Center Director on January 14, 2005 does not stay any period for response and awaiting the outcome of the decision does not serve to demonstrate the delay in filing the present petition was unavoidable.

In conclusion, the Petitioner has not demonstrated to the satisfaction of the Director that the delay in filing the required reply to the final action of December 1, 2003 from the due date for reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

Since the two-month extension of time was improperly charged to Deposit Account 08-0719, the account will be credited in due course.

Petitioner should consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an “unintentionally” abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was “unavoidable.” This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An “unintentional” petition under 37 CFR 1.137(b) must be accompanied by the \$1500 (\$750 for small entity) petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).


PETITION UNDER 37 CFR 1.102(c)(1)

Presently, the above-identified application remains abandoned and cannot be accorded special status. When the application is revive, a request for reconsideration of the petition to make special based on applicant’s health and age should be filed.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:	Mail Stop PETITION Commissioner for Patents P. O. Box 1450 Alexandria, VA 22313-1450
By facsimile:	(571) 273-8300 Attn: Office of Petitions
By hand:	U. S. Patent and Trademark Office Customer Service Window, Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314.

Telephone inquiries concerning this decision should be directed to Denise Pothier at (571) 272-4787.


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